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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,786	06/14/2005	Migaku Suzuki	124247	4301
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EXAMINER				
REICHLE, KARIN M				
ART UNIT		PAPER NUMBER		
3761				
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09/17/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/538,786

Applicant(s)

SUZUKI ET AL.

Examiner

Karin M. Reichle

Art Unit

3761

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Oath/Declaration

1. It is assumed that since in the Declaration, on page 1, neither of the boxes is checked and it is indicated one should be, and the text associated with the second box includes a space for an application number and an application number has been placed therein that the second box is indicated, i.e. checked.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

For Example:

Drawings

2. The drawings were received on 5-27-08. These drawings are not approved. For example, the sheets with new Figures 15C and 16C and D are not replacement sheets, but rather new sheets and should have been properly identified "New Sheet". The numbering of all the sheets of Figures has not been changed to reflect the proposed addition of two new sheets. Figures 30A and B have still not been labelled "PRIOR ART". Note page 15, lines 4-6 and page 18, line 11-page 19, line 2, i.e. described as "conventional", not "related". Descriptive text has

not been removed and is actually being added to proposed new Figures. Therefore see the following paragraphs.

3. The drawings are objected to because Figures 30A-B should be labeled as "Prior Art". Also, descriptive text, e.g. "DISCHARGED LIQUID", should be avoided in the Figures. The Figures are not consistent with the description thereof as now amended on pages 11-15. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the invention as claimed in claim 38, which is similar to claim 26 prior to amendment, and thereby claims 27 and 39 which depend

therefrom, see also discussion *infra*, must be shown or the feature(s) canceled from the claim(s).
No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Description

5. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: page 41, second full paragraph and page 43, fifth line from the bottom.

6. The disclosure is objected to because of the following informalities: The description is replete with informalities. For example: 1) The Summary of the Invention section, i.e. a description of the invention of the claims, and the claims are not commensurate, e.g. where is the invention of page 4, section 1 set forth in the claims? Note however the discussion *infra*. 2) The description of the figures on pages 11-15 should be consistent with the Figures. 3) In the amended paragraph at page 4, line 1, the last line appears to be inaccurate, i.e. "absorber" should be --absorbent product--. 4) The description of the invention throughout the application is, at the very least, unclear/inconsistent (note the discussion *infra* also). For example, on page 19, lines 11-14 the surface sheet 10 is described as "liquid impermeable" and "liquid-impermeable" as being the property of not in effect allowing liquid to permeate. Yet, e.g., on page 26, last two full paragraphs and Figures 7F and G the surface sheet is described as having a "liquid permeable" portion and "liquid permeable" being a characteristic of in effect allowing liquid to permeate. How can the surface sheet which is "liquid impermeable" as defined also be "liquid permeable" as defined? For another example, a surface sheet is described as covering an upper surface of the absorber on lines 6-7 of claim 1 but is also described as providing the function of the amendment on the last three lines of claim 1, i.e. "without being absorbed by the upper surface thereof". However, see, e.g., page 3, first full paragraph, the abstract, page 16, lines 13-14, page 17, lines 1-7 and last paragraph, and pages 18, 19 and 24, first full paragraph, the paragraph bridging pages 56-57, and Figures 1B and 6F, i.e. liquid is absorbed by upper surface via the lower side thereof and by lateral surfaces of the absorber which include lateralmost edges of the upper surface, i.e. where they intersect with the surfaces of the sides. Note claims 2, 4, 6, and 31 with regard to the description in the last three lines of claim 1 also. For a final example,

the description of the various sheets in claims 38, 27 and 39 and, e.g., page 45, first full paragraph, Figures 15A-B, 18A-18C, page 48, line 3-page 52, line 3 of the application are also unclear/inconsistent, e.g. Figure 15B shows a surface sheet but does not show such between the main body and housing as claimed. A clear consistent description throughout the application should be set forth. The entire description should be carefully reviewed and revised, as necessary. Applicant is thanked in advance for his/her cooperation in placing the description in proper form.

Appropriate correction is required.

7. The amendment filed 5-27-08 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the abstract, last sentence. The abstract now sets forth the absorbent product "may" include various sheets and an absorber. The terminology "may" infers also "may not". Where is it originally disclosed, i.e. page number, line number, that the product does not include at least the described sheets and absorber?

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

8. Claims 6, 27, and 38-39 are objected to because of the following informalities: In claim 6, line 2, "surface...side" should be --upper surface--. In claim 38, the third to last line appears to include too many words. Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. Claims 1-6 and 8-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As discussed supra, at the very least, see also the discussion infra, the description of the surface sheet on lines 6-7 and the function of the last three lines appear to be inconsistent (Note again, e.g., page 3, first full paragraph, the abstract, page 16, lines 13-14, page 17, lines 1-7 and last paragraph, and pages 18, 19 and 24, first full paragraph, the paragraph bridging pages 56-57 of the instant specification), i.e. if liquid is absorbed by upper surface even though it is via the lower side thereof and liquid is absorbed by lateral surfaces of the absorber which include lateralmost edges of the upper surface, i.e. where they intersect, how can the liquid not be absorbed by the upper surface thereof as claimed? It is noted that the claimed absorption is not limited to direct absorption from the upper side of the upper surface. Claims 2, 4, 6 and 31 also appear to be inconsistent with the last three lines of claim 1, e.g. if a portion of the upper surface is exposed as claimed in claim 6, how can liquid supplied to the sheet not be absorbed by such exposed upper surface? Also, a positive antecedent basis for “the back sheet of the absorber” on the third to last line of claim 1 should be set forth. In claim 22, it is unclear whether the surface sheet, i.e. which is combined with the absorber, is also removeably received or not? In regard to claim 25, is the unit in claim 22 and at least one of the plurality of units in claim 25 one and the same, i.e. at a minimum how many units are being claimed? This also applies to claim 29. In claim 38, is the absorber in this claim and that in claim 1 one and the same? If so, how can the surface sheet, i.e. on the upper surface thereof, be between the main body and the housing as

claimed on the last two lines but the absorber be received by the housing as claimed on the second and third lines from the bottom?

10. Claims 1-6 and 8-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 now claims an absorbent product with a surface sheet which is liquid-impermeable positioned on an upper side, a back sheet which is liquid-impermeable positioned on a lower side, and an absorber containing super absorbent polymer to absorb discharged liquid positioned between the surface sheet and the back sheet, wherein the surface sheet fully covers in a lateral direction, and partially or fully covers in a longitudinal direction, an upper surface of the absorber, and a flow passage is provided to allow a part or all of the discharged liquid supplied to the surface sheet to move to a side of the back sheet of the absorber, the discharged liquid supplied to the surface sheet being absorbed from lateral and lower surfaces of the absorber without being absorbed by the upper surface thereof. However, as discussed supra in paragraphs 6 and 9, while the originally filed application, e.g. page 3, first full paragraph, the abstract, page 16, lines 13-14, page 17, lines 1-7 and last paragraph, and pages 18, 19 and 24, first full paragraph and the paragraph bridging pages 56-57 of the instant specification, describes such product allowing a part or all of the discharged liquid supplied to the surface sheet to move to a side of the back sheet of the absorber and the discharged liquid supplied to the surface sheet be absorbed from lateral and lower surfaces of the absorber as well as from the upper surface thereof at the lateralmost edges and/or the lower side thereof, this is

not what is claimed. Note again the claimed absorption is not limited to direct absorption from the upper side of the upper surface covered by such surface sheet. If Applicant maintains such language, the specific portion of the original specification which provides support for the entire scope of the combination of each claim in a single embodiment should be set forth.

11. Claims 1-6 and 8-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As set forth in MPEP 2164.04, the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. While the analysis and conclusion of a lack of enablement are based on the factors discussed in MPEP 2164.01(a) and the evidence as a whole, it is not necessary to discuss each factor in the written rejection. The language should focus on those factors, reasons and evidence that lead the examiner to conclude the specification fails to teach how to make and use the claimed invention without undue experimentation or that the scope of enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims.

First, what is the claimed invention? Claim 1 recites an absorbent product with a surface sheet which is liquid-impermeable positioned on an upper side, a back sheet which is liquid-impermeable positioned on a lower side, and an absorber containing super absorbent polymer to absorb discharged liquid positioned between the surface sheet and the back sheet, wherein the surface sheet fully covers in a lateral direction, and partially or fully covers in a longitudinal direction, an upper surface of the absorber, and a flow passage is provided to allow a part or all

of the discharged liquid supplied to the surface sheet to move to a side of the back sheet of the absorber, the discharged liquid supplied to the surface sheet being absorbed from lateral and lower surfaces of the absorber **without being absorbed by the upper surface thereof.**

(Emphasis added).

However, see, e.g., page 3, first full paragraph, the abstract, page 16, lines 13-14, page 17, lines 1-7 and last paragraph, pages 18, 19 and 24, first full paragraph and the paragraph bridging pages 56-57, if liquid is absorbed by the upper surface even though such is via the lower side thereof and by the lateral surfaces of the absorber which include lateralmost edges of the upper surface, i.e. where they intersect, how can the liquid be absorbed as now claimed in last three lines of claim 1, i.e. without being absorbed by the upper surface? Note the invention claimed in the dependent claims also, e.g. claim 6, i.e. if a portion of the upper surface is exposed, how can liquid supplied to the sheet not be absorbed by such exposed upper surface? Therefore, at the very most, note the discussion in paragraphs 6 and 9-10 *supra* also, the claimed subject matter is not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim Language Interpretation

12. With regard to claim 1 and thereby the claims which depend therefrom, see paragraph 10 and thereby, MPEP 2163.06, I. Therefore, claim 1 is interpreted to require an absorbent product structured as claimed on lines 1-9 which functions with regard to discharged liquid as claimed on the last three lines. Note however the discussion in paragraphs 6, 9 and 11

supra also. Also, due to the lack of antecedent basis the side on the third to last line of claim 1 will be interpreted as some side of the back sheet. In claim 20, the terminology “means” on line 3 is interpreted not to invoke 35 USC 112, sixth paragraph. Claim 20 is also a product by process claim, see MPEP 2113, i.e. “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966.” The end product of claim 20 is considered to be a liquid-permeable non-woven fabric with a coat of super absorbent polymer. “Coat” is defined by the dictionary as “a layer of one substance covering another” (emphasis added). Due to the lack of clarity set forth supra, claim 22 is interpreted to require the sheet also be removeably received. Claim 25 is interpreted to require at least one laminated absorber unit in addition to the unit of claim 22. This interpretation also applies to claim 29. Claim 38 is interpreted to require the surface sheet between the internal space and the absorber.

Response to Arguments

13. Applicant’s remarks have been carefully considered but are deemed either moot in that the issue discussed has not been reraised or deemed not persuasive for the reasons set forth supra. The claims as now amended, note again paragraph 10 and MPEP 2163.06, I, distinguish over the prior art. However again note the discussion in paragraphs 6, 9 and 11.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any new grounds of rejection were necessitated by the amendments to claims 1-6 and 8-34, the addition of claims 35-39 and the amendments to the specification.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (571) 272-4936. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Karin M. Reichle/
Primary Examiner, Art Unit 3761

September 12, 2008